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| 10/568,068 | 02/13/2006 | John Riordan | 285135US2PCT | 7460 |
| 22850 7590 01/12/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER KARIKARI, KWASI | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2617 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/568,068 | Applicant(s) RIORDAN ET AL. | |
| | Examiner KWASI KARIKARI | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed on 10/22/2008 with respect to claims 1-18 and 19-40 in the remarks, have been considered but are moot in view of the new ground(s) of rejection necessitated by the new limitations added to the pending claims. See the rejection below of claims 19-40 for relevant citations found in Husemann, Ylitalo and Njemanze disclosing the newly added limitations in claims 19-40 which are similar to the cancelled claims 1-18.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claimed limitations "ringing tone", in claims 19 and 28; and "wherein the mode of operation determines whether incoming calls are accepted or directed to a voice mailbox", in claims 37-38 are not clearly described in the specification as originally filed and this constitute new matter. For example, the

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Applicant recites pages 3,11 and 1-12 support such claimed features. However, such claimed features are not found on the cited pages.

For examination purposes, the Examiner would interpret the rejected claimed limitations in the broadest scope of the Applicant's invention. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 19-22, 26-31 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann et al., (US 20040199056), (hereinafter Husemann) in view of Ylitalo et al., (US 20040203768), (hereinafter, Ylitalo).

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Regarding claims 19 and 28, Husemann discloses a mobile communication device/method (= device 104 is configured to communicate with wireless unit 108, see 0028-29, 0035 and 0037), including a plurality of modes of operation related to at least one of body-related parameters of an user or environmental parameters of the mobile communication device being able to be captured by the mobile communication device by at least one of sensors or measuring devices (devices 108 and 104 communicate with each other to monitor physiological condition of a patient; and device 104 is configured to operate in various modes, see [0028-29 and 0037]), the mobile communication device comprising:

a selection module configured to evaluate the at least one of the body-related parameters of the user or the environmental parameters of the mobile communication device (=selected routine according to an input, see [0029, 0036-37 and 0047]); and

an operational mode module configured to adapt a respective mode of operation of the mobile communication device according to evaluation data for the at least one of the body- related parameters or the environmental parameters (in the second mode, device 104 may transmit distress signal to device 108, see [0037, 0039-40]); but fails to mention that the plurality of modes are related to incoming calls and a ring tone.

However, **Ylitalo**, which is an analogous art, teaches a phone that includes multiple settings/profiles of ringing tone or ringing volume for particular location or situation in relationship with calls (see [0003-4, 0034-35 and 0072]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Ylitalo with the system of Husemann for the benefit of

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achieving a system that includes multiple ringing tones for different situation or location (see **Ylitalo**; [0034-35]).

Regarding claims 20 and 29, as recited in claims 19 and 28, **Husemann** further discloses the mobile communication device, wherein a body-related parameter of the user that is able to be captured by the mobile communication device by sensors includes at least one of a cardiac rhythm, an adrenaline level, an oxygen content of blood, a blood sugar content, a body position, a brain activity, a type of movement, a direction of movement, a vocal activity, or a pitch of the voice of the user as body-related parameter (see [0049, 0052-53 and 0055]).

Regarding claims 21 and 30, as recited in claims 19 and 28, **Husemann** fails to disclose “wherein an environmental parameter for the environment of the mobile communication device that is able to be captured by the mobile communication device by sensors includes at least one of a noise level, an air temperature, or a light value for the surrounding area of the communication device”.

However, **Ylitalo**, which is an analogous art, teaches “wherein an environmental parameter for the environment of the mobile communication device that is able to be captured by the mobile communication device by sensors includes at least one of a noise level, an air temperature, or a light value for the surrounding area of the communication device” (= increasing of ringing volume at a noisy environment, see [0035, 0077]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Ylitalo with the system of Husemann for the benefit of achieving a system that includes multiple ringing tones for different situation or location (see **Ylitalo**; [0034-35]).

Regarding claims 22 and 31, as recited in claims 19 and 31, **Husemann** further discloses the mobile communication device, wherein the mobile communication device comprises a mobile radio device connectible to a communication network (see [0037 and 0039]).

Regarding claims 26 and 35, as recited in claims 19 and 28, **Husemann** further discloses the mobile communication device, wherein the selection module comprises a predefinable threshold for triggering alarm functions by the mobile communication device for the at least one of the body-related parameter or for the environmental parameter (see [0032 and 0039]).

Regarding claims 27 and 36, as recited in claims 19 and 28, **Husemann** further discloses the mobile communication device, wherein the mobile communication device comprises at least one sensor able to be actuated by the user (see [0029 and 0053]).

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Regarding claims 37 and 38, as recited in claims 19 and 28, **Husemann** fails to disclose “wherein the mode of operation determines whether incoming calls are accepted or directed to a voice mailbox”.

However, **Ylitalo**, which is an analogous art, teaches “wherein the mode of operation determines whether incoming calls are accepted or directed to a voice mailbox” (= call screening/filtering [0035, 0077]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Ylitalo with the system of Husemann for the benefit of achieving a system that includes multiple ringing tones for different situation or location (see **Ylitalo**; [0034-35]).

Regarding claims 39 and 40, as recited in claims 19 and 28, **Husemann** fails to disclose “wherein said selection module is further configured to evaluate a body position of the user and a noise level of an environment, and said operational module is further configured to choose a soundless mode of operation of the mobile communication device based on the body position and the noise level”.

However, **Ylitalo**, which is an analogous art, teaches “wherein said selection module is further configured to evaluate a body position of the user and a noise level of an environment (= increasing of ringing volume at a noisy environment such as outdoor or driving automobile, see [0034-35, 0077]), and said operational module is further configured to choose a soundless mode of operation of the mobile communication

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device based on the body position and the noise level” (= turn off ringing volume or changing ring mode to vibration during meeting, see [0034 and 0042]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Ylitalo with the system of Husemann for the benefit of achieving a system that includes multiple ringing tones for different situation or location (see **Ylitalo**; [0034-35]).

4. **Claims 23-25 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Husemann in view of Ylitalo and further in view of Njemanze (US 6,390,979 B1), (hereinafter Njemanze).**

Regarding claims 23 and 32, as recited in claims 19 and 28, **Husemann** discloses the mobile communication device and communication network (=device 104 is configured to communicate with wireless unit 108 such as PDA and network 115, see 0028-29, 0035 and 0037); but the combination of Husemann and Ylitalo fails to mention that the mobile communication device comprises “a play station”.

However, **Njemanze**, which is an analogous art, teaches monitoring system uses a play station for individual physiological responses (see col. 2, lines 49-65 and col. 6, lines 16-40).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Njemanze with the system of Husemann and Ylitalo for the

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benefit of achieving a monitoring system which includes a play station for monitoring individual physiological responses (see **Njemanze**; col. 6, lines 16-40).

Regarding claims 24 and 33, as recited in claim 19 and 28, **Husemann** discloses the mobile communication device, an expert module and means of which the selection of the mode of operation by the user (= device 104 is configured to communicate with wireless unit 108, and processing unit 119, see 0028-29 and 0036-37); but the combination of Husemann and Ylitalo fails to mention “pattern recognition” in dependence upon the at least one body-related parameters of the user and/or environmental parameters for the mobile communication device is trainable.

However, **Njemanze**, which is an analogous art, teaches neurocognitive strategies allowing pretest classification of subjects and prediction of expected results; and training (see col. 2, lines 49-65, col. 3, lines 28-42 and col. 5, lines 6-26).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Njemanze with the system of Husemann and Ylitalo for the benefit of achieving a monitoring system which includes trained neural nets (see **Njemanze**; col. 3, lines 36-46).

Regarding claims 25 and 34, as recited in claims 24 and 33, the combination of **Husemann and Ylitalo** fails to disclose “wherein the expert module comprises at least one neural network for pattern recognition.

However, **Njemanze**, which is an analogous art, teaches neurocognitive

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strategies allowing pretest classification of subjects and prediction of expected results; and training (see col. 2, lines 49-65, col. 3, lines 28-42 and col. 5, lines 6-26).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Njemanze with the system of Husemann and Ylitalo for the benefit of achieving a monitoring system which includes trained neural nets (see **Njemanze**; col. 3, lines 36-46).

CONCLUSION

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. SEE MPEP 2141.02 [R-5] VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kwasi Karikari/
Patent Examiner Art Unit 2617.

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617